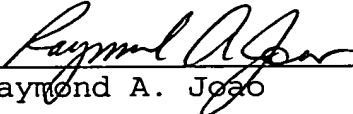




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Raymond A. Joao

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT : RAYMOND A. JOAO
SERIAL NO.: 09/515,060
FILED : FEBRUARY 28, 2000
FOR : APPARATUS AND METHOD FOR PROVIDING
EDUCATIONAL MATERIALS AND/OR RELATED
SERVICES IN A NETWORK ENVIRONMENT
EXAMINER : K. FIELDS GROUP: 2153

Assistant Commissioner for Patents
Washington, D.C. 20231

APPEAL BRIEF

Sir:

This is an Appeal Brief in support of Applicant's Appeal from the Examiner's Final Rejection of Claims 1, 2, 4-7, 9, 11-19 and 21-26, in the Office Action, dated March 28, 2001.

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A check in the amount of \$155.00, for the required fee, is submitted herewith.

Applicant has previously submitted a request for a one-month extension of time to file the Appeal Brief. A copy of the Request For A One-Month Extension Of Time To File An Appeal Brief, a copy of the Petition For Extension Of Time Under 37 CFR 1.136(a), a copy of the Check in the amount of \$55.00 for the required fee under 37 C.F.R. 1.17(a)(1), all of which were filed on July 11, 2001, is submitted herewith. Applicant also submits herewith a copy of the return receipt postcard acknowledging receipt of the above documents and check for \$55.00 by the U.S. Patent and Trademark Office.

I. REAL PARTY IN INTEREST:

The real party in interest is the inventor,
Raymond Anthony Joao.

II. RELATED APPEALS AND INTERFERENCES:

There are no appeals or interferences, which are known to the Applicant, which are either related to the present Appeal, or which will directly affect, be directly

affected by, or which may have a bearing on, the Board's decision in the present Appeal.

III. STATUS OF CLAIMS:

Claims 1, 2, 4-7, 9, 11-19 and 21-26 are the subject of the present Appeal. The Application was filed with twenty claims, namely Claims 1-20. During the prosecution of the application, Claims 3, 8, 10 and 20 were cancelled, without prejudice, and Claims 21-26 were added. Claims 1, 2, 4-7, 9, 11-19 and 21-26 are presently pending in the application for Appeal purposes. Claims 1, 2, 4-7, 9, 11-19 and 21-26 were rejected by the Examiner.

IV. STATUS OF AMENDMENTS:

No amendments were filed subsequent to the Examiner's Final Rejection of Claims 1, 2, 4-7, 9, 11-19 and 21-26 in the Office Action, dated March 28, 2001.

V. SUMMARY OF THE INVENTION:

The present invention pertains to an apparatus

for providing educational materials in a network environment. The present invention also pertains to a method for providing educational materials in a network environment.

The present invention, as defined by independent Claim 1, pertains to an apparatus for providing educational materials (page 2, lines 7-13; page 5, lines 11-19; page 41, lines 7-14), comprising: a processing device (Figure 1, central processing computer 10, page 42, line 18 to page 45, line 11; Figure 2, central processing unit (CPU) 11, page 46, lines 6-8; page 46, line 3 to page 60, line 10) for processing a request from an individual to receive educational material (page 76, line 6 to page 89, line 12; Figures 4A and 4B, steps 52 to steps 63), wherein said educational material is at least one of video material, audio material, and video and audio material (page 47, line 17 to page 48, line 12; page 56, lines 3-11; originally filed Claim 1, page 126, lines 6-8), a memory device for storing said educational material (database 19, Figure 2, page 47, line 13 to page 49, line 20; page 56, lines 3-11), a transmitter for transmitting said educational material to the individual (transmitter 13, Figure 2, page 46, lines 15-19; Figures 4A and 4B, step 63, steps 52 through 63, page 89, lines 9-12) in response to said request to receive said

educational material (Figures 4A and 4B, steps 52 through 63, page 42, line 18 to page 46, line 3; page 89, lines 9-12), wherein said transmitter is controlled by said processing device (page 46, lines 15-19; page 89, lines 9-12, Figures 4A and 4B, step 63) and a receiver (receiver 12, Figure 2, page 46, lines 11-15) for receiving a transmission termination signal from the individual (page 46, lines 11-14; page 75, lines 19 to page 76, line 6; Figures 4A and 4B, step 51; page 60, line 18, to page 61, line 7; page 90, lines 17-21, Figures 4A and 4B, step 64; originally filed Claim 1, page 126, lines 14-15). The processing device terminates the transmission of said educational material in response to the termination signal (page 90, line 17 to page 91, line 17, Figures 4A and 4B, step 64, step 65 and step 55), and further wherein said processing device at least one of identifies, records, and stores, a first location (page 91, lines 1 to page 92, line 9; Figures 4A and 4B, step 65; page 50, line 1 to page 51, line 13; monitoring device 21, Figure 2; page 71, lines 8-18; page 54, lines 4-15, page 68, lines 10-21), wherein said first location is the location in said educational material where the transmission of said educational material is terminated (page 71, line 8 to page 72, line 4; page 91, lines 1-5; page 78, lines 12-22) and further wherein a subsequent transmission of said educational

material to the individual commences from a second location which is located before said first location in said educational material (page 79, lines 1-16; page 80, lines 6 to page 89, line 12; Figures 4A and 4B, step 62 and step 63), and further wherein said subsequent transmission of said educational material includes a transmission of at least a portion of said educational material previously transmitted to the individual (page 79, lines 1-16; page 80, lines 6 to page 89, line 12; Figures 4A and 4B, step 62 and step 63).

The present invention, as defined by independent Claim 16, pertains to a method for providing educational materials in a network environment (page 2, lines 7-13; page 5, lines 11-19; page 41, lines 7-14), comprising: storing educational material (database 19, Figure 2, page 47, line 13 to page 49, line 20; page 56, lines 3-11), processing a request from an individual to receive said educational material (Figure 1, central processing computer 10, page 42, line 18 to page 45, line 11; Figure 2, central processing unit (CPU) 11, page 46, lines 6-8; page 46, line 3 to page 60, line 10; page 76, line 6 to page 89, line 12; Figures 4A and 4B, steps 52 to steps 63), wherein said educational material is at least one of video material, audio material, and video and audio material (page 47, line ~~17~~ to page 48,

line 12; page 56, lines 3-11; originally filed Claim 1, page 126, lines 6-8), transmitting said educational material to the individual in response to said request to receive said educational material (transmitter 13, Figure 2, page 46, lines 15-19; Figures 4A and 4B, steps 52 through 63, page 89, lines 9-12; page 42, line 18 to page 46, line 3; page 89, lines 9-12), receiving a transmission termination signal from the individual (page 90, lines 17-21, Figures 4A and 4B, step 64; originally filed Claim 1, page 126, lines 14-15; page 46, lines 11-14; page 75, lines 19 to page 76, line 6; Figures 4 and 4B, step 51; page 60, line 18, to page 61, line 7), processing said transmission termination signal (page 90, line 17 to page 91, line 17; Figures 4A and 4B, step 64, step 65 and step 55), terminating the transmission of said educational material (page 91, lines 1-17; Figures 4A and 4B, step 65 and step 55), at least one of identifying, recording, and storing, a first location (page 91, lines 1 to page 92, line 9; Figures 4A and 4B, step 65; page 50, line 1 to page 51, line 13; monitoring device 21, Figure 2; page 71, lines 8-18; page 54, lines 4-15, page 68, lines 10-21), wherein said first location is the location in said educational material where the transmission of said educational material is terminated (page 71, line 8 to page 72, line 4; page 91, lines 1-5; page 78, lines 12-22).

A subsequent transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material (page 79, lines 1-16; page 80, lines 6 to page 89, line 12; Figures 4A and 4B, step 62 and step 63), and further wherein said subsequent transmission of said educational material includes a transmission of at least a portion of said educational material previously transmitted to the individual (page 79, lines 1-16; page 80, lines 6 to page 89, line 12; Figures 4A and 4B, step 62 and step 63).

The present invention, as defined by independent Claim 18, pertains to an apparatus for providing educational materials (page 2, lines 7-13; page 5, lines 11-19; page 41, lines 7-14), comprising: a memory device for storing educational material (database 19, Figure 2, page 47, line 13 to page 49, line 20; page 56, lines 3-11), wherein said educational material is at least one of video material, audio material, and video and audio material (page 47, line 17 to page 48, line 12; page 56, lines 3-11; originally filed Claim 1, page 126, lines 6-8), a receiver (receiver 12, Figure 2, page 46, lines 11-15) for receiving a request from an individual to receive said educational material (page 46, lines 11-14; page 75, lines 19 to page 76, line 6; Figures 4

and 4B, step 51; page 60, line 18, to page 61, line 7), a processing device for processing said request (Figure 1, central processing computer 10, page 42, line 18 to page 45, line 11; Figure 2, central processing unit (CPU) 11, page 46, lines 6-8; page 46, line 3 to page 60, line 10) and a transmitter for transmitting said educational material to the individual (transmitter 13, Figure 2, page 46, lines 15-19; Figures A and 4B, step 63, steps 52 through 63, page 89, lines 9-12; page 42, line 18 to page 46, line 3; page 89, lines 9-12). The receiver receives a transmission termination signal from the individual (page 46, lines 11-14; page 75, lines 19 to page 76, line 6; Figures 4 and 4B, step 51; page 60, line 18, to page 61, line 7; page 90, lines 17-21, Figures 4A and 4B, step 64; originally filed Claim 1, page 126, lines 14-15), and wherein said processor processes said transmission termination signal and terminates the transmission of said educational material (page 90, line 17 to page 91, line 17; Figures 4A and 4B, step 64, step 65 and step 55), and further wherein said processor at least one of identifies and stores a first location in said educational material where said transmission is terminated (page 91, lines 1 to page 92, line 9; Figures 4A and 4B, step 65; page 50, line 1 to page 51, line 13; monitoring device 21, Figure 2; page 71, lines 8-18; page 54, lines 4-15, page 68, lines

10-21), wherein a subsequent transmission of said educational material commences from a second location (page 79, lines 1-16; page 80, lines 6 to page 89, line 12; Figures 4A and 4B, step 62 and step 63), wherein said second location is a location in said educational material which is located before said first location and includes an amount of educational material review during said subsequent transmission (page 79, lines 1-16; page 80, lines 6 to page 89, line 12; Figures 4A and 4B, step 62 and step 63).

The present invention, as defined by independent Claim 25, pertains to an apparatus for providing educational materials (page 2, lines 7-13; page 5, lines 11-19; page 41, lines 7-14), comprising: a processing device (Figure 1, central processing computer 10, page 42, line 18 to page 45, line 11; Figure 2, central processing unit (CPU) 11, page 46, lines 6-8; page 46, line 3 to page 60, line 10) for processing a request from an individual to receive educational material (page 76, line 6 to page 89, line 12; Figures 4A and 4B, steps 52 to steps 63), wherein said educational material is at least one of video material, audio material, and video and audio material (page 47, line 17 to page 48, line 12; page 56, lines 3-11; originally filed

Claim 1, page 126, lines 6-8), a memory device for storing said educational material (database 19, Figure 2, page 47, line 13 to page 49, line 20; page 56, lines 3-11), a transmitter for transmitting said educational material to the individual (transmitter 13, Figure 2, page 46, lines 15-19; Figures 4A and 4B, step 63, steps 52 through 63, page 89, lines 9-12) in response to said request to receive said educational material (Figures 4A and 4B, steps 52 through 63, page 42, line 18 to page 46, line 3; page 89, lines 9-12), wherein said transmitter is controlled by said processing device (page 46, lines 15-19; page 89, lines 9-12, Figures 4A and 4B, step 63), and a receiver (receiver 12, Figure 2, page 46, lines 11-15) for receiving a transmission termination signal from the individual (page 46, lines 11-14; page 75, lines 19 to page 76, line 6; Figures 4A and 4B, step 51; page 60, line 18, to page 61, line 7; page 90, lines 17-21, Figures 4A and 4B, step 64; originally filed Claim 1, page 126, lines 14-15). The processing device terminates the transmission of said educational material in response to the termination signal (page 90, line 17 to page 91, line 17, Figures 4A and 4B, step 64, step 65 and step 55), and further wherein said processing device at least one of identifies, records, and stores, a first location (page 91, lines 1 to page 92,

line 9; Figures 4A and 4B, step 65; page 50, line 1 to page 51, line 13; monitoring device 21, Figure 2; page 71, lines 8-18; page 54, lines 4-15, page 68, lines 10-21), wherein said first location is the location in said educational material where the transmission of said educational material is terminated (page 71, line 8 to page 72, line 4; page 91, lines 1-5; page 78, lines 12-22), and further wherein a subsequent transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material (page 79, lines 1-16; page 80, lines 6 to page 89, line 12; Figures 4A and 4B, step 62 and step 63), and further wherein said processing device stores information regarding at least one of said first location and said second location in an educational file corresponding to the individual (page 91, lines 1-12, Figures 4A and 4B, step 65), and further wherein said subsequent transmission of said educational material includes a transmission of an amount of educational material review (page 79, lines 1-16; page 80, lines 6 to page 89, line 12; Figures 4A and 4B, step 62 and step 63).

VI. ISSUES:

A. Whether Claims 1, 2, 4-7, 9, 11, 16-19 and 24-26 are unpatentable under 35 U.S.C. §103(a) over Houstis et al., Internet, Education, and the Web (Houstis) in view of Dunn et al., U.S. Patent No. 5,721,829 (Dunn).

1. Whether Claims 1, 2, 4-7, 9, 11, 21 and 24 are unpatentable under 35 U.S.C. §103(a) over Houstis in view of Dunn.

2. Whether Claims 16 and 17 are unpatentable under 35 U.S.C. §103(a) over Houstis in view of Dunn.

3. Whether Claims 18, 19 and 23 are unpatentable under 35 U.S.C. §103(a) over Houstis in view of Dunn.

4. Whether Claims 25 and 26 are unpatentable under 35 U.S.C. §103(a) over Houstis in view of Dunn.

B. Whether Claim 12 is unpatentable under 35 U.S.C. §103(a) over Houstis in view of Dunn and further in view of Dwyer et al., Creating a Virtual Classroom for Interactive Education on the Web (Dwyer).

C. Whether Claims 13, 14, 22, and 23 are unpatentable under 35 U.S.C. §103(a) over Houstis in view of Dunn and further in view of Goldberg, World Wide Web - Course Tool: An Environment for Building WWW - Based Courses (Goldberg).

D. Whether Claim 15 is unpatentable under 35 U.S.C. §103(a) over Houstis in view of Dunn and further in view of Hamalainen et al., Electronic Markets for Learning: Educational Brokerages on the Internet (Hamalainen).

VII. GROUPING OF THE CLAIMS:

Applicant respectfully submits that Claims 1, 2, 4-7, 9, 11-19, and 21-26 contain four (4) independent claims (Claims 1, 16, 18 and 25) and, therefore, four groups of claims consisting of Claims 1, 2, 4-7, 9, 11-15, 21, 22 and 24 (Group A), Claims 16 and 17 (Group B), Claims 18, 19 and 23 (Group C) and Claims 25 and 26 (Group D).

Applicant respectfully submits that Claims 1, 2, 4-7, 9, 11-19, and 21-26 do not stand or fall together. Applicant respectfully submits that Claims 1, 2, 4-7, 9, 11-15, 21, 22 and 24 (Group A) do not stand or fall together. Applicant further respectfully submits that Claims 16 and 17 (Group B) do not stand or fall together. Applicant further respectfully submits that Claims 18, 19 and 23 (Group C) do not stand or fall together. Applicant further respectfully submits that Claims 25 and 26 (Group D) do not stand or fall together.

VIII. ARGUMENTS:

The Examiner, in the Office Action, dated March 28, 2001, asserts that Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Houstis et al., Internet, Education, and the Web (Houstis) in view of Dunn, et al., U.S. Patent No. 5,721,829 (Dunn). The Examiner also asserts that Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Houstis et al., Internet, Education, and the Web (Houstis) in view of Dunn, et al., U.S. Patent No. 5,721,829 (Dunn) and further in

view of Dwyer et al., Creating a Virtual Classroom for Interactive Education on the Web (Dwyer).

The Examiner also asserts that Claims 13, 14, 22 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Houstis et al., Internet, Education, and the Web (Houstis) in view of Dunn, et al., U.S. Patent No. 5,721,829 (Dunn) and further in view of Goldberg, World Wide Web - Course Tool: An Environment for Building WWW - Based Courses (Goldberg). Lastly, the Examiner asserts that Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over Houstis et al., Internet, Education, and the Web (Houstis) in view of Dunn, et al., U.S. Patent No. 5,721,829 (Dunn) and further in view of Hamalainen et al., Electronic Markets for Learning: Educational Brokerages on the Internet (Hamalainen).

Applicant respectfully submits that the Examiner's rejections of Claims 1, 2, 4-7, 9, 11-19, and 21-26 are untenable, improper, and contrary to controlling case law. Applicant further respectfully submits that the Examiner's rejections of Claims 1, 2, 4-7, 9, 11-19, and 21-26 should be reversed.

A(1). CLAIMS 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26
ARE PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26 are patentable over Hustis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of Claims 1, 2, 4-7, 9, 11, 16-19, 21 and 24-26 is improper and should be reversed.

a. CLAIM 1 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by independent Claim 1, is patentable over Hustis in view of Dunn. Applicant respectfully submits that the asserted combination of Hustis and Dunn does not disclose or suggest the present invention as defined by independent Claim 1. Applicant further respectfully submits that there is no teaching, motivation, or suggestion, in Hustis, Dunn, or their combination, for combining Hustis and Dunn in the manner espoused by the Examiner. In this regard, Applicant submits that the Examiner's asserted rejection of independent Claim 1 is untenable and should be reversed.

Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention, as defined by independent Claim 1. Applicant submits that the asserted combination of Houstis and Dunn does not disclose or suggest an apparatus for providing educational materials, comprising a processing device for processing a request from an individual to receive educational material, wherein said educational material is at least one of video material, audio material, and video and audio material, a memory device for storing said educational material, a transmitter for transmitting said educational material to the individual in response to said request to receive said educational material, wherein said transmitter is controlled by said processing device, and a receiver for receiving a transmission termination signal from the individual, wherein said processing device terminates the transmission of said educational material in response to the termination signal, and further wherein said processing device at least one of identifies, records, and stores, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated, and further wherein a subsequent transmission of said educational material to the

individual commences from a second location which is located before said first location in said educational material, and further wherein said subsequent transmission of said educational material includes a transmission of at least a portion of said educational material previously transmitted to the individual, all of which features are specifically recited features of independent Claim 1.

In particular, Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest a processing device wherein said processing device at least one of identifies, records, and stores, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated, and further wherein a subsequent transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material, and further wherein said subsequent transmission of said educational material includes a transmission of at least a portion of said educational material previously transmitted to the individual, all of which features are specifically recited features of independent Claim 1.

Applicant respectfully submits that there is no teaching, motivation, or suggestion, in Houstis, Dunn, or their combination, for combining the teachings of Houstis and Dunn, in the manner espoused by the Examiner, in order to render independent Claim 1 unpatentable. Applicant further respectfully submits that the Examiner engaged in hindsight in combining the teachings of Houstis and Dunn, which is improper and contrary to controlling case law governing obviousness determinations as set forth by the Court of Appeals for the Federal Circuit. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant submits that Houstis pertains to an article which discusses Internet, Education, and the Web. In the Office Action, dated March 28, 2001, the Examiner, at page 3, lines 3-7, stated:

"Houstis does not disclose a processing device which one of identifies, records, and stores a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual." Office Action, dated March 28, 2001, page 3, lines 3-7.

Applicant respectfully submits that the difference between the claimed invention and Houstis, which is clearly recognized by the Examiner, is a substantial difference, indeed, and further provides clear and indisputable evidence for distinguishing the present invention, as defined by independent Claim 1, over Houstis.

Applicant respectfully submits that Dunn discloses a system for automatic pause/resume of content delivered on a channel in response to switching to and from that channel and resuming so that a portion of the content is repeated. The Examiner, in the Office Action, dated March 28, 2001, stated:

Dunn discloses a system which one of identifies, records, and stores, a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual; wherein the material is marked and a transmitter transmits information regarding the second location to the user; the second location being computed prior to a subsequent transmission, wherein the amount of material re-transmitted is programmably selected. Office Action, dated March 28, 2001, page 3, lines 8-15.

The Examiner further stated:

"It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Houstis with the ability to begin a subsequent transmission by retransmitting a portion of the material previously transmitted to the user as disclosed by Dunn. The rationale is as follows: it would have been desirable to enable a user to start and stop the transmission of material, whereby upon the subsequent transmission the user's memory was refreshed by replaying a portion of the material that had been previously transmitted. As Dunn teaches the desirability of retransmitting a portion of the material previously transmitted, one of ordinary skill in the art would have been motivated by Dunn's teaching to provide the remote education system of Houstis with the ability to start and stop a transmission, whereby the start of the subsequent transmission included a portion of the material previously transmitted, thereby refreshing the user's memory. Office Action, dated March 28, 2001, page 3, line 16 to page 4, line 6.

Applicant respectfully submits that the Examiner's asserted rejection of independent Claim 1 is untenable and contrary to controlling case law governing obviousness determinations as set forth by the Court of Appeals for the Federal Circuit. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

The Examiner, in relying on Houstis as a primary reference in his obviousness determination, recognized a significant and patentable distinction between the present invention and Houstis ("Houstis does not disclose a processing device which one of identifies, records, and

stores a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual." Office Action, dated March 28, 2001, page 3, lines 3-7).

Applicant respectfully submits that the Examiner improperly relied upon Dunn in an attempt to supply the missing elements of independent Claim 1. Applicant submits that the Examiner's reasoning in support of his rejection of independent Claim 1 serves to further support Applicant's position that the Examiner engaged in the use of hindsight in reaching the asserted obviousness determination regarding independent Claim 1.

In the Office Action, dated March 28, 2001, the Examiner stated:

"While applicant's specific field of endeavor may be considered remote education or distance learning, applicant's general field of endeavor is concerned with transmitting multimedia data on demand to remote users. Likewise, Dunn focuses on precisely

the same field of endeavor; i.e., transmitting multimedia data on demand to remote users. The difference between the two being that applicant deals with educational material while Dunn deals with entertainment material". Office Action, dated March 28, 2001, page 9, lines 1-6.

Applicant respectfully disagrees with the above comments of the Examiner and with the Examiner's attempt to categorize the present invention into a general field of endeavor. Applicant respectfully submits that the preamble of independent Claim 1 clearly and specifically recites "An apparatus for providing educational materials, comprising:".

Applicant also submits that the Examiner's comments are inconsistent. On one hand, the Examiner recognizes a difference between the educational material which is provided by the present invention and the entertainment material with which Dunn pertains. On the other hand, Applicant respectfully submits that the Examiner improperly attempts to group the present invention and the teachings of Dunn into a same field of endeavor in order to provide support for the asserted combination of Dunn and Houstis. Applicant respectfully submits that the above comments of the Examiner are untenable and further show that no evidence of any

teaching, motivation, or suggestion, exists for combining the teachings of Houstis and Dunn in the asserted manner.

Applicant further respectfully submits that the Examiner's comments provide further evidence of the Examiner's use of hindsight in reaching his obviousness determination regarding independent Claim 1.

The Examiner further stated:

"Examiner maintains the position that the combination of Houstis and Dunn is proper. The motivation to combine the references is clear and particular as required by governing case law. Dunn plainly described the desirability of retransmitting a portion of the material to the viewer in order to refresh the user's memory (column 7, line 34 - column 8, line 11). As Dunn teaches the desirability of retransmitting a portion of material previously viewed by a user, one of ordinary skill in the art would have been motivated by Dunn's teaching to provide the remote education system of Houstis with the ability to restart a transmission by retransmitting a portion of the material previously viewed, thereby refreshing the user's memory by reviewing the old material." Office Action, dated March 28, 2001, page 9, lines 7-14.

Applicant respectfully submits that the Examiner's reasons in support of his rejection of independent Claim 1 further serve to support Applicant's position that the Examiner utilized hindsight in rejecting independent Claim 1.

Applicant submits that the Examiner looked beyond the teachings of Houstis and Dunn only after utilizing independent Claim 1 as a blueprint.

Applicant submits that the Examiner improperly looked beyond the teachings of Houstis and Dunn and, therefore, utilized hindsight by attempting to classify the Applicant's general field of endeavor as being concerned with transmitting multimedia data on demand to remote users. See Office Action, dated March 28, 2001, page 9, lines 1-3. Thereafter, the Examiner stated: "Likewise, Dunn focuses on precisely the same field of endeavor; i.e., transmitting multimedia data on demand to remote users." Office Action, dated March 28, 2001, page 9, lines 3-4. Applicant respectfully submits that the Examiner improperly attempted to combine the teachings of Houstis and Dunn in order to piece together the elements and features of independent Claim 1 in order to arrive at the asserted obviousness determination regarding said claim.

Applicant respectfully submits that the Examiner's reasoning evidences the fact that the Examiner improperly looked beyond the teachings of Houstis and Dunn by providing his own hindsight-based nexus for combining the two references

only after using independent Claim 1 as a blueprint. Applicant respectfully submits that the Examiner's actions were improper and contrary to controlling case law. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant respectfully submits that the Examiner's statements, in support of the asserted combination of the teachings of Houstis and Dunn, also lacked the clarity and particularity which is required and dictated by controlling case law. In re Dembiczak, 175 F.3d 994.

Applicant further submits that the Examiner's statements, in support of the asserted combination of Houstis and Dunn, were broad and conclusory and amounted to the Examiner's utilization of hindsight, which is improper. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant submits that the Examiner's reasons, in support of the rejection of independent Claim 1, were broad and conclusory and, therefore, failed to provide evidence in support of the asserted rejection of independent Claim 1. The Court of Appeals for the Federal Circuit has stated that

"[b]road conclusory statements regarding the teachings of multiple references, standing alone, are not 'evidence'." In re Dembiczak, 175 F.3d at 999.

Applicant further submits that the Examiner merely stated that the motivation to combine the Houstis and Dunn references "is clear and particular as required by governing case law." Office Action, dated March 28, 2001, page 9, lines 7-8. The Examiner also stated: "Dunn plainly describes the desirability of retransmitting a portion of the material to the viewer in order to refresh the user's memory (column 7, line 34 - column 8, line 11)." Office Action, dated March 28, 2001, page 9, lines 9-10. Applicant respectfully disagrees with the Examiner.

Applicant submits that the Examiner failed to point to any teaching, motivation, or suggestion, for combining the teachings of Houstis and Dunn with the clarity and particularity required by controlling case law. In re Dembiczak, 175 F.3d at 994. Applicant respectfully submits that the portion of Dunn cited by the Examiner (column 7, line 34 - column 8, line 11) does not provide any teaching, motivation, or suggestion, for combining Houstis and Dunn in the manner espoused by the Examiner.

Applicant respectfully submits that the Examiner has failed to point to any teaching, motivation, or suggestion, implicit or explicit, in either Houstis or Dunn, for supporting the asserted combination of Houstis and Dunn and the asserted rejection of independent Claim 1.

In In Re Dembiczak, the Court of Appeals for the Federal Circuit stated "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." In re Dembiczak, 175 F.3d at 999. The Court of Appeals for the Federal Circuit also stated that "... the showing must be clear and particular." In re Dembiczak, 175 F.3d at 999.

In view of the foregoing, Applicant respectfully submits that the Examiner improperly utilized hindsight in order to piece together the elements of independent Claim 1, from the teachings of Houstis and Dunn, only after using Applicant's claimed invention, as defined by independent Claim 1, as a blueprint, an approach which is untenable and

contrary to the existing state of the law. In Re Rouffet, 149 F.3d 1350.

The Court of Appeals for the Federal Circuit in In Re Rouffet, stated:

"Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" In Re Rouffet, 149 F.3d at 1357 (Fed. Cir. 1998).

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of independent Claim 1. Applicant further respectfully submits that the present invention, as defined by independent Claim 1, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of independent Claim 1 is improper and should be reversed by the Board. Accordingly, Applicant respectfully

requests that the Examiner's rejection of independent Claim 1 be reversed.

b. CLAIM 2 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by Claim 2, is patentable over Houstis in view of Dunn. Applicant respectfully submits that the present invention, as defined by Claim 2, is not rendered obvious by Houstis in view of Dunn.

Claim 2 depends directly from independent Claim 1. Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 1. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a) regarding the patentability of independent Claim 1.

Applicant further submits that the asserted combination of Houstis and Dunn does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 1, and wherein said education material is at least one of encoded,

marked, digitally encoded, analog encoded, digitally marked, analog marked, time-marked, time-stamped, and frame numbered, and further wherein said processing device processes said first location in conjunction with an amount of educational material review to generate said second location, all of which features are specifically recited features of Claim 2.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 2. Applicant further respectfully submits that the present invention, as defined by Claim 2, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 2 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 2 be reversed.

c. CLAIM 4 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by Claim 4, is patentable over Houstis in view of Dunn. Applicant respectfully submits that the

present invention, as defined by Claim 4, is not rendered obvious by Houstis in view of Dunn.

Claim 4 depends directly from independent Claim 1. Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 1. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a) regarding the patentability of independent Claim 1.

Applicant further submits that the asserted combination of Houstis and Dunn does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 1, and wherein said memory device is linked to one of a computer system, a database, a data source, and an educational information source, located external from said apparatus, all of which features are specifically recited features of Claim 4.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of

Claim 4. Applicant further respectfully submits that the present invention, as defined by Claim 4, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 4 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 4 be reversed.

d. CLAIM 5 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by Claim 5, is patentable over Houstis in view of Dunn. Applicant respectfully submits that the present invention, as defined by Claim 5, is not rendered obvious by Houstis in view of Dunn.

Claim 5 depends directly from independent Claim 1. Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 1. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a) regarding the patentability of independent Claim 1.

Applicant further submits that the asserted combination of Houstis and Dunn does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 1, and wherein said transmitter transmits one of an announcement, an update, and information, to the individual, wherein said one of an announcement, an update, and information, contains at least one of educational material, administrative material, testing material, registration material, scheduling material, course material, and program material, all of which features are specifically recited features of claim 5.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 5. Applicant further respectfully submits that the present invention, as defined by Claim 5, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 5 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 5 be reversed.

e. CLAIM 6 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by Claim 6, is patentable over Houstis in view of Dunn. Applicant respectfully submits that the present invention, as defined by Claim 6, is not rendered obvious by Houstis in view of Dunn.

Claim 6 depends directly from independent Claim 1. Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 1. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A) (1) (a) regarding the patentability of independent Claim 1.

Applicant further submits that the asserted combination of Houstis and Dunn does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 1, and wherein said transmitter transmits educational material containing at least two of multimedia information, audio

information, video information, graphical information, text information, and a live broadcast, simultaneously, all of which features are specifically recited features of Claim 6.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 6. Applicant further respectfully submits that the present invention, as defined by Claim 6, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 6 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 6 be reversed.

f. CLAIM 7 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by Claim 7, is patentable over Houstis in view of Dunn. Applicant respectfully submits that the present invention, as defined by Claim 7, is not rendered obvious by Houstis in view of Dunn.

Claim 7 depends directly from independent

Claim 1. Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 1. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A) (1) (a) regarding the patentability of independent Claim 1.

Applicant further submits that the asserted combination of Houstis and Dunn does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 1, and wherein said processing device computes said second location one of during a current educational session and prior to a subsequent educational session, all of which features are specifically recited features of Claim 7.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 7. Applicant further respectfully submits that the present invention, as defined by Claim 7, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 7 is improper and should be reversed by the Board.

Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 7 be reversed.

g. CLAIM 9 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by Claim 9, is patentable over Houstis in view of Dunn. Applicant respectfully submits that the present invention, as defined by Claim 9, is not rendered obvious by Houstis in view of Dunn.

Claim 9 depends directly from independent Claim 1. Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 1. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a) regarding the patentability of independent Claim 1.

Applicant further submits that the combination of Houstis and Dunn does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 1, and wherein said receiver receives a request from an individual to receive

said educational material, and further wherein said processing device identifies said educational material requested, all of which features are specifically recited features of Claim 9.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 9. Applicant further respectfully submits that the present invention, as defined by Claim 9, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 9 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 9 be reversed.

h. CLAIM 11 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by Claim 11, is patentable over Houstis in view of Dunn. Applicant respectfully submits that the present invention, as defined by Claim 11, is not rendered obvious by Houstis in view of Dunn.

Claim 11 depends directly from independent Claim 1. Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 1. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a) regarding the patentability of independent Claim 1.

Applicant further submits that the asserted combination of Houstis and Dunn does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 1, and which further comprises a remote user device for receiving said educational material at a location remote from said processing device, all of which features are specifically recited features of Claim 11.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 11. Applicant further respectfully submits that the present invention, as defined by Claim 11, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of

Claim 11 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 11 be reversed.

i. CLAIM 21 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by Claim 21, is patentable over Houstis in view of Dunn. Applicant respectfully submits that the present invention, as defined by Claim 21, is not rendered obvious by Houstis in view of Dunn.

Claim 21 depends directly from independent Claim 1. Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 1. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a) regarding the patentability of independent Claim 1.

Applicant further submits that the asserted combination of Houstis and Dunn does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 1, and which

further comprises a transmitter for transmitting information regarding at least one of said first location, an amount of educational material review, and said second location, to the individual, all of which features are specifically recited features of Claim 21.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 21. Applicant further respectfully submits that the present invention, as defined by Claim 21, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 21 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 21 be reversed.

j. CLAIM 24 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by Claim 24, is patentable over Houstis in view of Dunn. Applicant respectfully submits that the present invention, as defined by Claim 24, is not rendered obvious by Houstis in view of Dunn.

Claim 24 depends directly from independent Claim 1. Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 1. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a) regarding the patentability of independent Claim 1.

Applicant further submits that the asserted combination of Houstis and Dunn does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 1, and wherein said receiver receives a request from the individual to at least one of re-view and replay at least one of said educational material, a segment of said educational material, and a portion of said educational material, all of which features are specifically recited features of Claim 24.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 24. Applicant further respectfully submits that the present invention, as defined by Claim 24, is patentable over

Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 24 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 24 be reversed.

A(2). CLAIMS 16 AND 17 ARE PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that Claims 16 and 17 are patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of Claims 16 and 17 is improper and should be reversed.

a. CLAIM 16 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by independent Claim 16, is patentable over Houstis in view of Dunn. Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 16. Applicant further respectfully submits that there is no teaching, motivation, or suggestion, in Houstis, Dunn, or their combination, for combining Houstis

and Dunn in the manner espoused by the Examiner. In this regard, Applicant submits that the Examiner's asserted rejection of independent Claim 16 is untenable and should be reversed.

Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention, as defined by independent Claim 16. Applicant submits that the asserted combination of Houstis and Dunn does not disclose or suggest a method for providing educational materials in a network environment, comprising storing educational material, processing a request from an individual to receive said educational material, wherein said educational material is at least one of video material, audio material, and video and audio material, transmitting said educational material to the individual in response to said request to receive said educational material, receiving a transmission termination signal from the individual, processing said transmission termination signal, terminating the transmission of said educational material, at least one of identifying, recording, and storing, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated, wherein a subsequent

transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material, and further wherein said subsequent transmission of said educational material includes a transmission of at least a portion of said educational material previously transmitted to the individual, all of which features are specifically recited features of independent Claim 16.

In particular, Applicant submits that the asserted combination of Houstis and Dunn does not disclose or suggest at least one of identifying, recording, and storing, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated, wherein a subsequent transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material, and further wherein said subsequent transmission of said educational material includes a transmission of at least a portion of said educational material previously transmitted to the individual, all of which features are specifically recited features of independent Claim 16.

Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a) regarding the patentability of independent Claim 1.

Applicant respectfully submits that there is no teaching, motivation, or suggestion, in Houstis, Dunn, or their combination, for combining the teachings of Houstis and Dunn, in the manner espoused by the Examiner, in order to render independent Claim 16 unpatentable. Applicant further respectfully submits that the Examiner engaged in hindsight in combining the teachings of Houstis and Dunn, which is improper and contrary to controlling case law governing obviousness determinations as set forth by the Court of Appeals for the Federal Circuit. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant submits that Houstis pertains to an article which discusses Internet, Education, and the Web. As noted above, in the Office Action, dated March 28, 2001, the Examiner, at page 3, lines 3-7, stated:

"Houstis does not disclose a processing device which one of identifies, records, and stores a first location, wherein said first location is the

location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual." Office Action, dated March 28, 2001, page 3, lines 3-7.

Applicant respectfully submits that the difference between the claimed invention and Houstis, which is clearly recognized by the Examiner, is a substantial difference, indeed, and further provides clear and indisputable evidence for distinguishing the present invention, as defined by independent Claim 16, over Houstis.

Applicant respectfully submits that Dunn discloses a system for automatic pause/resume of content delivered on a channel in response to switching to and from that channel and resuming so that a portion of the content is repeated. The Examiner, in the Office Action, dated March 28, 2001, stated:

Dunn discloses a system which one of identifies, records, and stores, a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual; wherein the material is marked and a transmitter transmits information regarding the

second location to the user; the second location being computed prior to a subsequent transmission, wherein the amount of material re-transmitted is programmably selected. Office Action, dated March 28, 2001, page 3, lines 8-15.

The Examiner further stated:

"It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Houstis with the ability to begin a subsequent transmission by retransmitting a portion of the material previously transmitted to the user as disclosed by Dunn. The rationale is as follows: it would have been desirable to enable a user to start and stop the transmission of material, whereby upon the subsequent transmission the user's memory was refreshed by replaying a portion of the material that had been previously transmitted. As Dunn teaches the desirability of retransmitting a portion of the material previously transmitted, one of ordinary skill in the art would have been motivated by Dunn's teaching to provide the remote education system of Houstis with the ability to start and stop a transmission, whereby the start of the subsequent transmission included a portion of the material previously transmitted, thereby refreshing the user's memory. Office Action, dated March 28, 2001, page 3, line 16 to page 4, line 6.

Applicant respectfully submits that the Examiner's asserted rejection of independent Claim 16 is untenable and contrary to controlling case law governing obviousness determinations as set forth by the Court of Appeals for the Federal Circuit. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

The Examiner, in relying on Houstis as a primary reference in his obviousness determination, recognized a significant and patentable distinction between the present invention and Houstis ("Houstis does not disclose a processing device which one of identifies, records, and stores a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual." Office Action, dated March 28, 2001, page 3, lines 3-7).

Applicant respectfully submits that the Examiner improperly relied upon Dunn in an attempt to supply the missing elements of independent Claim 16. Applicant submits that the Examiner's reasoning in support of his rejection of independent Claim 16 serves to further support Applicant's position that the Examiner engaged in the use of hindsight in reaching the asserted obviousness determination regarding independent Claim 16.

In the Office Action, dated March 28, 2001, the Examiner stated:

"While applicant's specific field of endeavor may be considered remote education or distance learning, applicant's general field of endeavor is concerned with transmitting multimedia data on demand to remote users. Likewise, Dunn focuses on precisely the same field of endeavor; i.e., transmitting multimedia data on demand to remote users. The difference between the two being that applicant deals with educational material while Dunn deals with entertainment material". Office Action, dated March 28, 2001, page 9, lines 1-6.

Applicant respectfully disagrees with the above comments of the Examiner and with the Examiner's attempt to categorize the present invention into a general field of endeavor. Applicant respectfully submits that the preamble of independent Claim 16 clearly and specifically recites "A method for providing educational materials in a network environment, comprising:".

Applicant also submits that the Examiner's comments are inconsistent. On one hand, the Examiner recognizes a difference between the educational material provided by the present invention and the entertainment material with which Dunn pertains. On the other hand, Applicant respectfully submits that the Examiner improperly attempts to group the

present invention and the teachings of Dunn into a same field of endeavor in order to provide support for the asserted combination of Dunn and Houstis. Applicant respectfully submits that the above comments of the Examiner are untenable and further show that no evidence of any teaching, motivation, or suggestion, exists for combining the teachings of Houstis and Dunn in the asserted manner.

Applicant further respectfully submits that the Examiner's comments further evidence the Examiner's use of hindsight in reaching his obviousness determination regarding independent Claim 16.

The Examiner further stated:

"Examiner maintains the position that the combination of Houstis and Dunn is proper. The motivation to combine the references is clear and particular as required by governing case law. Dunn plainly described the desirability of retransmitting a portion of the material to the viewer in order to refresh the user's memory (column 7, line 34 - column 8, line 11). As Dunn teaches the desirability of retransmitting a portion of material previously viewed by a user, one of ordinary skill in the art would have been motivated by Dunn's teaching to provide the remote education system of Houstis with the ability to restart a transmission by retransmitting a portion of the material previously viewed, thereby refreshing the user's memory by reviewing the old material." Office Action, dated March 28, 2001, page 9, lines 7-14.

Applicant respectfully submits that the Examiner's reasons in support of his rejection of independent Claim 16 further serve to support Applicant's position that the Examiner utilized hindsight in rejecting independent Claim 16. Applicant submits that the Examiner looked beyond the teachings of Houstis and Dunn only after utilizing independent Claim 16 as a blueprint.

Applicant submits that the Examiner improperly looked beyond the teachings of Houstis and Dunn and, therefore, utilized hindsight by attempting to classify the Applicant's general field of endeavor as being concerned with transmitting multimedia data on demand to remote users. See Office Action, dated March 28, 2001, page 9, lines 1-3. Thereafter, the Examiner stated: "Likewise, Dunn focuses on precisely the same field of endeavor; i.e., transmitting multimedia data on demand to remote users." Office Action, dated March 28, 2001, page 9, lines 3-4. Applicant respectfully submits that the Examiner improperly attempted to combine the teachings of Houstis and Dunn in order to piece together the elements and features of independent Claim 16 in

order to arrive at the asserted obviousness determination regarding said claim.

Applicant respectfully submits that the Examiner's reasoning evidences the fact that the Examiner improperly looked beyond the teachings of Houstis and Dunn by providing his own hindsight-based nexus for combining the two references only after using independent Claim 16 as a blueprint. Applicant respectfully submits that the Examiner's actions were improper and contrary to controlling case law. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant respectfully submits that the Examiner's statements, in support of the asserted combination of the teachings of Houstis and Dunn, also lacked the clarity and particularity which is required and dictated by controlling case law. In re Dembiczak, 175 F.3d 994.

Applicant further submits that the Examiner's statements in support of the asserted combination of Houstis and Dunn were broad and conclusory and amounted to the Examiner's utilization of hindsight, which is improper. In Re

Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant submits that the Examiner's reasons, in support of the rejection of independent Claim 16, were broad and conclusory and, therefore, failed to provide evidence in support of the asserted rejection of independent Claim 16. The Court of Appeals for the Federal Circuit has stated that "[b]road conclusory statements regarding the teachings of multiple references, standing alone, are not 'evidence'." In re Dembiczak, 175 F.3d at 999.

Applicant further submits that the Examiner merely stated that the motivation to combine the Houstis and Dunn references "is clear and particular as required by governing case law." Office Action, dated March 28, 2001, page 9, lines 7-8. The Examiner also stated: "Dunn plainly describes the desirability of retransmitting a portion of the material to the viewer in order to refresh the user's memory (column 7, line 34 - column 8, line 11)." Office Action, dated March 28, 2001, page 9, lines 9-10. Applicant respectfully disagrees with the Examiner.

Applicant submits that the Examiner failed to point to any teaching, motivation, or suggestion, for combining the teachings of Houstis and Dunn with the clarity and particularity required by controlling case law. In re Dembiczak, 175 F.3d at 994. Applicant respectfully submits that the portion of Dunn cited by the Examiner (column 7, line 34 - column 8, line 11) does not provide any teaching, motivation, or suggestion, for combining Houstis and Dunn in the manner espoused by the Examiner.

Applicant respectfully submits that the Examiner has failed to point to any teaching, motivation, or suggestion, implicit or explicit, in either Houstis or Dunn, for supporting the asserted combination of Houstis and Dunn and the asserted rejection of independent Claim 16.

In In Re Dembiczak, the Court of Appeals for the Federal Circuit stated "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." In re Dembiczak, 175 F.3d at 999. The Court of Appeals for the Federal

Circuit also stated that "... the showing must be clear and particular." In re Dembiczak, 175 F.3d at 999.

In view of the foregoing, Applicant respectfully submits that the Examiner improperly utilized hindsight in order to piece together the elements of independent Claim 16 from the teachings of Houstis and Dunn, only after using Applicant's claimed invention, as defined by independent Claim 16, as a blueprint, an approach which is untenable and contrary to the existing state of the law. In Re Rouffet, 149 F.3d 1350.

The Court of Appeals for the Federal Circuit in In Re Rouffet, stated:

"Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" In Re Rouffet, 149 F.3d at 1357 (Fed. Cir. 1998).

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of independent Claim 16. Applicant further respectfully submits that the present invention, as defined by independent Claim 16, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of independent Claim 16 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of independent Claim 16 be reversed.

b. CLAIM 17 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by Claim 17, is patentable over Houstis in view of Dunn. Applicant respectfully submits that the present invention, as defined by Claim 17, is not rendered obvious by Houstis in view of Dunn.

Claim 17 depends directly from independent Claim 16. Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 16.

Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(2)(a) regarding the patentability of independent Claim 16.

Applicant further submits that the asserted combination of Houstis and Dunn does not disclose or suggest a method for providing educational materials in a network environment, which has all of the recited features of independent Claim 16, and wherein said education material is at least one of encoded, marked, digitally encoded, analog encoded, digitally marked, analog marked, time-marked, time-stamped, and frame numbered, and further wherein said method further comprises processing said first location in conjunction with an amount of educational material review to generate said second location, all of which features are specifically recited features of Claim 17.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 17. Applicant further respectfully submits that the present invention, as defined by Claim 17, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of

Claim 17 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 17 be reversed.

**A(3). CLAIMS 18 AND 19 ARE PATENTABLE OVER HOUSTIS
IN VIEW OF DUNN:**

Applicant respectfully submits that Claims 18 and 19 are patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of Claims 18 and 19 is improper and should be reversed.

a. CLAIM 18 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by independent Claim 18, is patentable over Houstis in view of Dunn. Applicant respectfully submits that the combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 18. Applicant further respectfully submits that there is no teaching, motivation, or suggestion, in Houstis, Dunn, or their combination, for combining Houstis and Dunn in the manner espoused by Examiner. In this regard, Applicant

submits that the Examiner's asserted rejection of independent Claim 18 is untenable and should be reversed.

Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention, as defined by independent Claim 18. Applicant submits that the asserted combination of Houstis and Dunn does not disclose or suggest an apparatus for providing educational materials, comprising a memory device for storing educational material, wherein said educational material is at least one of video material, audio material, and video and audio material, a receiver for receiving a request from an individual to receive said educational material, a processing device for processing said request, and a transmitter for transmitting said educational material to the individual, wherein said receiver receives a transmission termination signal from the individual, and wherein said processor processes said transmission termination signal and terminates the transmission of said educational material, and further wherein said processor at least one of identifies and stores a first location in said educational material where said transmission is terminated, wherein a subsequent transmission of said educational material commences from a second location, wherein said

second location is a location in said educational material which is located before said first location and includes an amount of educational material review during said subsequent transmission, all of which features are specifically recited features of independent Claim 18.

In particular, Applicant submits that the asserted combination of Houstis and Dunn does not disclose or suggest a processing device wherein said processor at least one of identifies and stores a first location in said educational material where said transmission is terminated, wherein a subsequent transmission of said educational material commences from a second location, wherein said second location is a location in said educational material which is located before said first location and includes an amount of educational material review during said subsequent transmission, all of which features are specifically recited features of independent Claim 18.

Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a) regarding the patentability of independent Claim 1.

Applicant respectfully submits that there is no teaching, motivation, or suggestion, in Houstis, Dunn, or their combination, for combining the teachings of Houstis and Dunn, in the manner espoused by the Examiner, in order to render independent Claim 18 unpatentable. Applicant further respectfully submits that the Examiner engaged in hindsight in combining the teachings of Houstis and Dunn, which is improper and contrary to controlling case law governing obviousness determinations as set forth by the Court of Appeals for the Federal Circuit. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant submits that Houstis pertains to an article which discusses Internet, Education, and the Web. As noted above, in the Office Action, dated March 28, 2001, the Examiner, at page 3, lines 3-7, stated:

"Houstis does not disclose a processing device which one of identifies, records, and stores a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual." Office Action, dated March 28, 2001, page 3, lines 3-7.

Applicant respectfully submits that the difference between the claimed invention and Houstis, which is clearly recognized by the Examiner, is a substantial difference, indeed, and further provides clear and indisputable evidence for distinguishing the present invention, as defined by independent Claim 18, over Houstis.

Applicant respectfully submits that Dunn discloses a system for automatic pause/resume of content delivered on a channel in response to switching to and from that channel and resuming so that a portion of the content is repeated. The Examiner, in the Office Action, dated March 28, 2001, stated:

Dunn discloses a system which one of identifies, records, and stores, a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual; wherein the material is marked and a transmitter transmits information regarding the second location to the user; the second location being computed prior to a subsequent transmission, wherein the amount of material re-transmitted is programmably selected. Office Action, dated March 28, 2001, page 3, lines 8-15.

The Examiner further stated:

"It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Houstis with the ability to begin a subsequent transmission by retransmitting a portion of the material previously transmitted to the user as disclosed by Dunn. The rationale is as follows: it would have been desirable to enable a user to start and stop the transmission of material, whereby upon the subsequent transmission the user's memory was refreshed by replaying a portion of the material that had been previously transmitted. As Dunn teaches the desirability of retransmitting a portion of the material previously transmitted, one of ordinary skill in the art would have been motivated by Dunn's teaching to provide the remote education system of Houstis with the ability to start and stop a transmission, whereby the start of the subsequent transmission included a portion of the material previously transmitted, thereby refreshing the user's memory. Office Action, dated March 28, 2001, page 3, line 16 to page 4, line 6.

Applicant respectfully submits that the Examiner's asserted rejection of independent Claim 18 is untenable and contrary to controlling case law governing obviousness determinations as set forth by the Court of Appeals for the Federal Circuit. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

The Examiner, in relying on Houstis as a primary reference in his obviousness determination, recognized a significant and patentable distinction between the present invention and Houstis ("Houstis does not disclose a processing device which one of identifies, records, and

stores a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual." Office Action, dated March 28, 2001, page 3, lines 3-7).

Applicant respectfully submits that the Examiner improperly relied upon Dunn in an attempt to supply the missing elements of independent Claim 18. Applicant submits that the Examiner's reasoning in support of his rejection of independent Claim 18 serves to further support Applicant's position that the Examiner engaged in the use of hindsight in reaching the asserted obviousness determination regarding independent Claim 18.

In the Office Action, dated March 28, 2001, the Examiner stated:

"While applicant's specific field of endeavor may be considered remote education or distance learning, applicant's general field of endeavor is concerned with transmitting multimedia data on demand to remote users. Likewise, Dunn focuses on precisely

the same field of endeavor; i.e., transmitting multimedia data on demand to remote users. The difference between the two being that applicant deals with educational material while Dunn deals with entertainment material". Office Action, dated March 28, 2001, page 9, lines 1-6.

Applicant respectfully disagrees with the above comments of the Examiner and with the Examiner's attempt to categorize the present invention into a general field of endeavor. Applicant respectfully submits that the preamble of independent Claim 18 clearly and specifically recites "An apparatus for providing educational materials, comprising:".

Applicant also submits that the Examiner's comments are inconsistent. On one hand, the Examiner recognizes a difference between the educational material provided by the present invention and the entertainment material with which Dunn pertains. On the other hand, Applicant respectfully submits that the Examiner improperly attempts to group the present invention and the teachings of Dunn into a same field of endeavor in order to provide support for the asserted combination of Dunn and Houstis. Applicant respectfully submits that the above comments of the Examiner are untenable and further show that no evidence of any teaching, motivation, or suggestion, exists for combining the teachings of Houstis and Dunn in the asserted manner.

The Examiner further stated:

"Examiner maintains the position that the combination of Houstis and Dunn is proper. The motivation to combine the references is clear and particular as required by governing case law. Dunn plainly described the desirability of retransmitting a portion of the material to the viewer in order to refresh the user's memory (column 7, line 34 - column 8, line 11). As Dunn teaches the desirability of retransmitting a portion of material previously viewed by a user, one of ordinary skill in the art would have been motivated by Dunn's teaching to provide the remote education system of Houstis with the ability to restart a transmission by retransmitting a portion of the material previously viewed, thereby refreshing the user's memory by reviewing the old material." Office Action, dated March 28, 2001, page 9, lines 7-14.

Applicant respectfully submits that the Examiner's reasons in support of his rejection of independent Claim 18 further serve to support Applicant's position that the Examiner utilized hindsight in rejecting independent Claim 18. Applicant submits that the Examiner looked beyond the teachings of Houstis and Dunn only after utilizing independent Claim 18 as a blueprint.

Applicant submits that the Examiner improperly looked beyond the teachings of Houstis and Dunn and, therefore, utilized hindsight by attempting to classify the

Applicant's general field of endeavor as being concerned with transmitting multimedia data on demand to remote users. See Office Action, dated March 28, 2001, page 9, lines 1-3. Thereafter, the Examiner stated: "Likewise, Dunn focuses on precisely the same field of endeavor; i.e., transmitting multimedia data on demand to remote users." Office Action, dated March 28, 2001, page 9, lines 3-4. Applicant respectfully submits that the Examiner improperly attempted to combine the teachings of Houstis and Dunn in order to piece together the elements and features of independent Claim 18 in order to arrive at the asserted obviousness determination regarding said claim.

Applicant respectfully submits that the Examiner's reasoning evidences the fact that the Examiner improperly looked beyond the teachings of Houstis and Dunn by providing his own hindsight-based nexus for combining the two references only after using independent Claim 18 as a blueprint. Applicant respectfully submits that the Examiner's actions were improper and contrary to controlling case law. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant respectfully submits that the Examiner's statements, in support of the asserted combination of the teachings of Houstis and Dunn, also lacked the clarity and particularity which is required and dictated by controlling case law. In re Dembiczak, 175 F.3d 994.

Applicant further submits that the Examiner's statements in support of the asserted combination of Houstis and Dunn were broad and conclusory and amounted to the Examiner's utilization of hindsight, which is improper. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant submits that the Examiner's reasons, in support of the rejection of independent Claim 18, were broad and conclusory and, therefore, failed to provide evidence in support of the asserted rejection of independent Claim 18. The Court of Appeals for the Federal Circuit has stated that "[b]road conclusory statements regarding the teachings of multiple references, standing alone, are not 'evidence'." In re Dembiczak, 175 F.3d at 999.

Applicant further submits that the Examiner merely stated that the motivation to combine the Houstis and Dunn

references "is clear and particular as required by governing case law." Office Action, dated March 28, 2001, page 9, lines 7-8. The Examiner also stated: "Dunn plainly describes the desirability of retransmitting a portion of the material to the viewer in order to refresh the user's memory (column 7, line 34 - column 8, line 11)." Office Action, dated March 28, 2001, page 9, lines 9-10. Applicant respectfully disagrees with the Examiner.

Applicant submits that the Examiner failed to point to any teaching, motivation, or suggestion, for combining the teachings of Houstis and Dunn with the clarity and particularity required by controlling case law. In re Dembiczak, 175 F.3d at 994. Applicant respectfully submits that the portion of Dunn cited by the Examiner (column 7, line 34 - column 8, line 11) does not provide any teaching, motivation, or suggestion, for combining Houstis and Dunn in the manner espoused by the Examiner.

Applicant respectfully submits that the Examiner has failed to point to any teaching, motivation, or suggestion, implicit or explicit, in either Houstis or Dunn, for supporting the asserted combination of Houstis and Dunn and the asserted rejection of independent Claim 18.

In In Re Dembiczak, the Court of Appeals for the Federal Circuit stated "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." In re Dembiczak, 175 F.3d at 999. The Court of Appeals for the Federal Circuit also stated that "... the showing must be clear and particular." In re Dembiczak, 175 F.3d at 999.

In view of the foregoing, Applicant respectfully submits that the Examiner improperly utilized hindsight in order to piece together the elements of independent Claim 18 from the teachings of Houstis and Dunn, only after using Applicant's claimed invention, as defined by independent Claim 18, as a blueprint, an approach which is untenable and contrary to the existing state of the law. In Re Rouffet, 149 F.3d 1350.

The Court of Appeals for the Federal Circuit in In Re Rouffet, stated:

"Therefore an examiner may often find every

element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" In Re Rouffet, 149 F.3d at 1357 (Fed. Cir. 1998).

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of independent Claim 18. Applicant further respectfully submits that the present invention, as defined by independent Claim 18, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of independent Claim 18 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of independent Claim 18 be reversed.

b. CLAIM 19 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by Claim 19, is patentable over Houstis in view of Dunn. Applicant respectfully submits that the

present invention, as defined by Claim 19, is not rendered obvious by Houstis in view of Dunn.

Claim 19 depends directly from independent Claim 18. Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 18. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A) (3) (a) regarding the patentability of independent Claim 18.

Applicant further submits that the asserted combination of Houstis and Dunn does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 18, and wherein said processing device processes said first location in conjunction with an amount of educational material review to one of determine, compute, and generate said second location one of subsequent to the termination of a transmission of said educational material and prior to a subsequent transmission of said educational materials to the individual, all of which features are specifically recited features of Claim 19.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 19. Applicant further respectfully submits that the present invention, as defined by Claim 19, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 19 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 19 be reversed.

A(4). CLAIMS 25 AND 26 ARE PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that Claims 25 and 26 are patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of Claims 25 and 26 is improper and should be reversed.

a. CLAIM 25 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by independent Claim 25, is patentable over Houstis in view of Dunn. Applicant respectfully submits

that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 25. Applicant further respectfully submits that there is no teaching, motivation, or suggestion, in Houstis, Dunn, or their combination, for combining Houstis and Dunn in the manner espoused by the Examiner. In this regard, Applicant submits that the Examiner's asserted rejection of independent Claim 25 is untenable and should be reversed.

Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention, as defined by independent Claim 25. Applicant submits that the asserted combination of Houstis and Dunn does not disclose or suggest an apparatus for providing educational materials, comprising a processing device for processing a request from an individual to receive educational material, wherein said educational material is at least one of video material, audio material, and video and audio material, a memory device for storing said educational material, a transmitter for transmitting said educational material to the individual in response to said request to receive said educational material, wherein said transmitter is controlled by said processing device, and a receiver for

receiving a transmission termination signal from the individual, wherein said processing device terminates the transmission of said educational material in response to the termination signal, and further wherein said processing device at least one of identifies, records, and stores, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated, and further wherein a subsequent transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material, and further wherein said processing device stores information regarding at least one of said first location and said second location in an educational file corresponding to the individual, and further wherein said subsequent transmission of said educational material includes a transmission of an amount of educational material review, all of which features are specifically recited features of independent Claim 25.

In particular, Applicant submits that the asserted combination of Houstis and Dunn does not disclose or suggest a processing device wherein said processing device at least one of identifies, records, and stores, a first location, wherein said first location is the location in said educational

material where the transmission of said educational material is terminated, and further wherein a subsequent transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material, and further wherein said processing device stores information regarding at least one of said first location and said second location in an educational file corresponding to the individual, and further wherein said subsequent transmission of said educational material includes a transmission of an amount of educational material review, all of which features are specifically recited features of independent Claim 25.

Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a) regarding the patentability of independent Claim 1.

Applicant respectfully submits that there is no teaching, motivation, or suggestion, in Houstis, Dunn, or their combination, for combining the teachings of Houstis and Dunn, in the manner espoused by the Examiner, in order to render independent Claim 25 unpatentable. Applicant further respectfully submits that the Examiner engaged in hindsight in

combining the teachings of Houstis and Dunn, which is improper and contrary to controlling case law governing obviousness determinations as set forth by the Court of Appeals for the Federal Circuit. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant submits that Houstis pertains to an article which discusses Internet, Education, and the Web. As noted above, in the Office Action, dated March 28, 2001, the Examiner, at page 3, lines 3-7, stated:

"Houstis does not disclose a processing device which one of identifies, records, and stores a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual." Office Action, dated March 28, 2001, page 3, lines 3-7.

Applicant respectfully submits that the difference between the claimed invention and Houstis, which is clearly recognized by the Examiner, is a substantial difference, indeed, and further provides clear and indisputable evidence for distinguishing the present invention, as defined by independent Claim 25, over Houstis.

Applicant respectfully submits that Dunn discloses a system for automatic pause/resume of content delivered on a channel in response to switching to and from that channel and resuming so that a portion of the content is repeated. The Examiner, in the Office Action, dated March 28, 2001, stated:

Dunn discloses a system which one of identifies, records, and stores, a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material is re-transmitted to the individual; wherein the material is marked and a transmitter transmits information regarding the second location to the user; the second location being computed prior to a subsequent transmission, wherein the amount of material re-transmitted is programmably selected. Office Action, dated March 28, 2001, page 3, lines 8-15.

The Examiner further stated:

"It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Houstis with the ability to begin a subsequent transmission by retransmitting a portion of the material previously transmitted to the user as disclosed by Dunn. The rationale is as follows: it would have been desirable to enable a user to start and stop the transmission of material, whereby upon the subsequent transmission the user's memory was refreshed by replaying a portion of the material that had been previously transmitted. As

Dunn teaches the desirability of retransmitting a portion of the material previously transmitted, one of ordinary skill in the art would have been motivated by Dunn's teaching to provide the remote education system of Houstis with the ability to start and stop a transmission, whereby the start of the subsequent transmission included a portion of the material previously transmitted, thereby refreshing the user's memory. Office Action, dated March 28, 2001, page 3, line 16 to page 4, line 6.

Applicant respectfully submits that the Examiner's asserted rejection of independent Claim 25 is untenable and contrary to controlling case law governing obviousness determinations as set forth by the Court of Appeals for the Federal Circuit. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

The Examiner, in relying on Houstis as a primary reference in his obviousness determination, recognized a significant and patentable distinction between the present invention and Houstis ("Houstis does not disclose a processing device which one of identifies, records, and stores a first location, wherein said first location is the location in the material where the transmission of the education material terminated, and further wherein a subsequent transmission of said material to the individual commences from a second location which is located before said first location such that at least a portion of the material

is re-transmitted to the individual." Office Action, dated March 28, 2001, page 3, lines 3-7).

Applicant respectfully submits that the Examiner improperly relied upon Dunn in an attempt to supply the missing elements of independent Claim 25. Applicant submits that the Examiner's reasoning in support of his rejection of independent Claim 25 serves to further support Applicant's position that the Examiner engaged in the use of hindsight in reaching the asserted obviousness determination regarding independent Claim 25.

In the Office Action, dated March 28, 2001, the Examiner stated:

"While applicant's specific field of endeavor may be considered remote education or distance learning, applicant's general field of endeavor is concerned with transmitting multimedia data on demand to remote users. Likewise, Dunn focuses on precisely the same field of endeavor; i.e., transmitting multimedia data on demand to remote users. The difference between the two being that applicant deals with educational material while Dunn deals with entertainment material". Office Action, dated March 28, 2001, page 9, lines 1-6.

Applicant respectfully disagrees with the above

comments of the Examiner and with the Examiner's attempt to categorize the present invention into a general field of endeavor. Applicant respectfully submits that the preamble of independent Claim 25 clearly and specifically recites "An apparatus for providing educational materials, comprising:".

Applicant also submits that the Examiner's comments are inconsistent. On one hand, the Examiner recognizes a difference between the educational material provided by the present invention and the entertainment material with which Dunn pertains. On the other hand, Applicant respectfully submits that the Examiner improperly attempts to group the present invention and the teachings of Dunn into a same field of endeavor in order to provide support for the asserted combination of Dunn and Houstis. Applicant respectfully submits that the above comments of the Examiner are untenable and further show that no evidence of any teaching, motivation, or suggestion, exists for combining the teachings of Houstis and Dunn in the asserted manner.

The Examiner further stated:

"Examiner maintains the position that the combination of Houstis and Dunn is proper. The motivation to combine the references is clear and

particular as required by governing case law. Dunn plainly described the desirability of retransmitting a portion of the material to the viewer in order to refresh the user's memory (column 7, line 34 - column 8, line 11). As Dunn teaches the desirability of retransmitting a portion of material previously viewed by a user, one of ordinary skill in the art would have been motivated by Dunn's teaching to provide the remote education system of Houstis with the ability to restart a transmission by retransmitting a portion of the material previously viewed, thereby refreshing the user's memory by reviewing the old material." Office Action, dated March 28, 2001, page 9, lines 7-14.

Applicant respectfully submits that the Examiner's reasons in support of his rejection of independent Claim 25 further serve to support Applicant's position that the Examiner utilized hindsight in rejecting independent Claim 25. Applicant submits that the Examiner looked beyond the teachings of Houstis and Dunn only after utilizing independent Claim 25 as a blueprint.

Applicant submits that the Examiner improperly looked beyond the teachings of Houstis and Dunn and, therefore, utilized hindsight by attempting to classify the Applicant's general field of endeavor as being concerned with transmitting multimedia data on demand to remote users. See Office Action, dated March 28, 2001, page 9, lines 1-3. Thereafter, the Examiner stated: "Likewise, Dunn focuses on

precisely the same field of endeavor; i.e., transmitting multimedia data on demand to remote users." Office Action, dated, March 28, 2001, page 9, lines 3-4. Applicant respectfully submits that the Examiner improperly attempted to combine the teachings of Houstis and Dunn in order to piece together the elements and features of independent Claim 25 in order to arrive at the asserted obviousness determination regarding said claim.

Applicant respectfully submits that the Examiner's reasoning evidences the fact that the Examiner improperly looked beyond the teachings of Houstis and Dunn by providing his own hindsight-based nexus for combining the two references only after using independent Claim 25 as a blueprint. Applicant respectfully submits that the Examiner's actions were improper and contrary to controlling case law. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant respectfully submits that the Examiner's statements, in support of the asserted combination of the teachings of Houstis and Dunn, also lacked the clarity and particularity which is required and dictated by controlling case law. In re Dembiczak, 175 F.3d 994.

Applicant further submits that the Examiner's statements in support of the asserted combination of Houstis and Dunn were broad and conclusory and amounted to the Examiner's utilization of hindsight, which is improper. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant submits that the Examiner's reasons, in support of the rejection of independent Claim 25, were broad and conclusory and, therefore, failed to provide evidence in support of the asserted rejection of independent Claim 25. The Court of Appeals for the Federal Circuit has stated that "[b]road conclusory statements regarding the teachings of multiple references, standing alone, are not 'evidence'." In re Dembiczak, 175 F.3d at 999.

Applicant further submits that the Examiner merely stated that the motivation to combine the Houstis and Dunn references "is clear and particular as required by governing case law." Office Action, dated March 28, 2001, page 9, lines 7-8. The Examiner also stated: "Dunn plainly describes the desirability of retransmitting a portion of the material to the viewer in order to refresh the user's memory (column 7,

line 34 - column 8, line 11)." Office Action, dated March 28, 2001, page 9, lines 9-10. Applicant respectfully disagrees with the Examiner.

Applicant submits that the Examiner failed to point to any teaching, motivation, or suggestion, for combining the teachings of Houstis and Dunn with the clarity and particularity required by controlling case law. In re Dembiczak, 175 F.3d at 994. Applicant respectfully submits that the portion of Dunn cited by the Examiner (column 7, line 34 - column 8, line 11) does not provide any teaching, motivation, or suggestion, for combining Houstis and Dunn in the manner espoused by the Examiner.

Applicant respectfully submits that the Examiner has failed to point to any teaching, motivation, or suggestion, implicit or explicit, in either Houstis or Dunn, for supporting the asserted combination of Houstis and Dunn and the asserted rejection of independent Claim 25.

In In Re Dembiczak, the Court of Appeals for the Federal Circuit stated "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application

of the requirement for a showing of the teaching or motivation to combine prior art references." In re Dembiczak, 175 F.3d at 999. The Court of Appeals for the Federal Circuit also stated that "... the showing must be clear and particular." In re Dembiczak, 175 F.3d at 999.

In view of the foregoing, Applicant respectfully submits that the Examiner improperly utilized hindsight in order to piece together the elements of independent Claim 25 from the teachings of Houstis and Dunn, only after using Applicant's claimed invention, as defined by independent Claim 25, as a blueprint, an approach which is untenable and contrary to the existing state of the law. In Re Rouffet, 149 F.3d 1350.

The Court of Appeals for the Federal Circuit in In Re Rouffet, stated:

"Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an

illogical and inappropriate process by which to determine patentability.'" In Re Rouffet, 149 F.3d at 1357 (Fed. Cir. 1998).

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of independent Claim 25. Applicant further respectfully submits that the present invention, as defined by independent Claim 25, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of independent Claim 25 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of independent Claim 25 be reversed.

b. CLAIM 26 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN:

Applicant respectfully submits that the present invention, as defined by Claim 26, is patentable over Houstis in view of Dunn. Applicant respectfully submits that the present invention, as defined by Claim 26, is not rendered obvious by Houstis in view of Dunn.

Claim 26 depends directly from independent

Claim 25. Applicant respectfully submits that the asserted combination of Houstis and Dunn does not disclose or suggest the present invention as defined by independent Claim 25. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A) (4) (a) regarding the patentability of independent Claim 25.

Applicant further submits that the combination of Houstis and Dunn does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 25, and wherein said amount of educational material review is at least one of programmably selected and selected by at least one of an administrator, an educator, and the individual, all of which features are specifically recited features of Claim 26.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 26. Applicant further respectfully submits that the present invention, as defined by Claim 26, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully submits that the Examiner's rejection of

Claim 26 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 26 be reversed.

B. CLAIM 12 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN AND FURTHER IN VIEW OF DWYER:

Applicant respectfully submits that the present invention, as defined by Claim 12, is patentable over Houstis in view of Dunn and further in view of Dwyer. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 12 is improper and should be reversed.

Claim 12 depends indirectly from independent Claim 1. Claim 12 depends directly from dependent Claim 11 which Claim 11, in turn, depends directly from independent Claim 1. As noted above, Applicant submits that independent Claim 1 and Claim 11 are patentable over the prior art. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a), regarding the patentability of independent Claim 1, and in Section VIII(A)(1)(h), regarding the patentability of Claim 11.

Applicant respectfully submits that Claim 12 is

patentable over Houstis in view of Dunn and further in view of Dwyer as Claim 12 depends from allowable subject matter.

Applicant respectfully submits that Claim 12 includes all of the limitations of independent Claim 1 and Claim 11 and further serves to narrow the scope of Claim 11. In this regard, Applicant submits that the asserted combination of Houstis, Dunn and Dwyer does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 1 and Claim 11, and wherein at least one of said apparatus and said remote user device further comprise a video recording device for facilitating video conferencing between users of the apparatus, all of which features are specifically recited features of Claim 12.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 12. Applicant further respectfully submits that the present invention, as defined by Claim 12, is patentable over Houstis in view of Dunn and further in view of Dwyer. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 12 is improper and should be

reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 12 be reversed.

C. CLAIMS 13, 14, 22 AND 23 ARE PATENTABLE OVER HOUSTIS IN VIEW OF DUNN AND FURTHER IN VIEW OF GOLDBERG:

Applicant respectfully submits that claims 13, 14, 22 and 23 are patentable over Houstis in view of Dunn and further in view of Goldberg. In this regard, Applicant respectfully submits that the Examiner's rejection of Claims 13, 14, 22 and 23 is improper and should be reversed.

1. CLAIM 13 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN AND FURTHER IN VIEW OF GOLDBERG:

Applicant respectfully submits that the present invention, as defined by Claim 13, is patentable over Houstis in view of Dunn and further in view of Goldberg.

Claim 13 depends directly from independent Claim 1. As noted above, Applicant submits that independent Claim 1 is patentable over the prior art. Applicant incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a) regarding the patentability of independent Claim 1. Applicant respectfully submits that

Claim 13 is patentable over Houstis in view of Dunn and further in view of Goldberg as Claim 13 depends from allowable subject matter.

Applicant respectfully submits that Claim 13 includes all of the limitations of independent Claim 1 and further serves to narrow the scope of independent Claim 1. In this regard, Applicant submits that the asserted combination of Houstis, Dunn and Goldberg does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 1, and which further comprises an input device for entering information concerning an update in the individual's one of status and progression related to said one of a course and a program of study, wherein said processing device processes said information and stored said information in said memory device, all of which features are specifically recited features of Claim 13.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 13. Applicant further respectfully submits that the present invention, as defined by Claim 13, is patentable over

Houstis in view of Dunn and further in view of Goldberg. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 13 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 13 be reversed.

**2. CLAIM 14 IS PATENTABLE OVER HOUSTIS IN VIEW
OF DUNN AND FURTHER IN VIEW OF GOLDBERG:**

Applicant respectfully submits that the present invention, as defined by Claim 14, is patentable over Houstis in view of Dunn and further in view of Goldberg.

Claim 14 depends directly from independent Claim 1. As noted above, Applicant submits that independent Claim 1 is patentable over the prior art. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a) regarding the patentability of independent Claim 1. Applicant respectfully submits that Claim 14 is patentable over Houstis in view of Dunn and further in view of Goldberg as Claim 14 depends from allowable subject matter.

Applicant respectfully submits that Claim 14 includes all of the limitations of independent Claim 1 and further serves to narrow the scope of independent Claim 1. In this regard, Applicant submits that the asserted combination of Houstis, Dunn and Goldberg does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 1, and wherein said processing device generates a notification signal containing information regarding at least one a course, a lecture, a program, and an information update regarding same, and further wherein said transmitter transmits said notification signal to one of the individual, a communication device associated with the individual, and a remote user device associated with the individual, all of which features are specifically recited features of Claim 14.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 14. Applicant further respectfully submits that the present invention, as defined by Claim 14, is patentable over Houstis in view of Dunn and further in view of Goldberg. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 14 is improper and should be

reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 14 be reversed.

**3. CLAIM 22 IS PATENTABLE OVER HOUSTIS IN VIEW
OF DUNN AND FURTHER IN VIEW OF GOLDBERG:**

Applicant respectfully submits that the present invention, as defined by Claim 22, is patentable over Houstis in view of Dunn and further in view of Goldberg.

Claim 22 depends directly from independent Claim 1. As noted above, Applicant submits that independent Claim 1 is patentable over the prior art. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a) regarding the patentability of independent Claim 1. Applicant respectfully submits that Claim 22 is patentable over Houstis in view of Dunn and further in view of Goldberg as Claim 22 depends from allowable subject matter.

Applicant respectfully submits that Claim 22 includes all of the limitations of independent Claim 1 and further serves to narrow the scope of independent Claim 1. In this regard, Applicant submits that the asserted combination

of Houstis, Dunn and Goldberg does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 1, and wherein said processing device at least one of determines whether an individual has progressed through at least one of said educational material, a segment of said educational material, and a portion of said educational material, determines whether the individual has submitted assignments related to said educational material, and determines whether the individual has taken a required examination, all of which features are specifically recited features of Claim 22.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 22. Applicant further respectfully submits that the present invention, as defined by Claim 22, is patentable over Houstis in view of Dunn and further in view of Goldberg. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 22 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 22 be reversed.

**4. CLAIM 23 IS PATENTABLE OVER HOUSTIS IN VIEW
OF DUNN AND FURTHER IN VIEW OF GOLDBERG:**

Applicant respectfully submits that the present invention, as defined by Claim 23, is patentable over Houstis in view of Dunn and further in view of Goldberg.

Claim 23 depends directly from independent Claim 18. As noted above, Applicant submits that independent Claim 18 is patentable over the prior art. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(3)(a) regarding the patentability of independent Claim 18. Applicant respectfully submits that Claim 23 is patentable over Houstis in view of Dunn and further in view of Goldberg as Claim 23 depends from allowable subject matter.

Applicant respectfully submits that Claim 23 includes all of the limitations of independent Claim 18 and further serves to narrow the scope of independent Claim 18. In this regard, Applicant submits that the asserted combination of Houstis, Dunn and Goldberg does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 18,

and wherein said processor determines whether an individual has progressed through at least one of said educational material, a segment of said educational material, and portion of said educational material, and further wherein said processor determines whether the individual has at least one of submitted an assignment related to said educational material and has taken a required examination, and further wherein said processor generates a first signal indicative of at least one of the individual's successful completion of said educational material and the individual's failure to successfully complete said educational material, and further wherein said transmitter transmits said first signal to at least one of the individual, an administrator, an instructor, and a third party, all of which features are specifically recited features of Claim 23.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 23. Applicant further respectfully submits that the present invention, as defined by Claim 23, is patentable over Houstis in view of Dunn and further in view of Goldberg. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 23 is improper and should be

reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 23 be reversed.

**D. CLAIM 15 IS PATENTABLE OVER HOUSTIS IN VIEW OF DUNN
AND FURTHER IN VIEW OF HAMALAINEN.**

Applicant respectfully submits that the present invention, as defined by Claim 15, is patentable over Houstis in view of Dunn and further in view of Hamalainen. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 15 is improper and should be reversed.

Claim 15 depends directly from independent Claim 1. As noted above, Applicant submits that independent Claim 1 is patentable over the prior art. Applicant hereby incorporates by reference herein and re-asserts the arguments presented above in Section VIII(A)(1)(a) regarding the patentability of independent Claim 1. Applicant respectfully submits that Claim 15 is patentable over Houstis in view of Dunn and further in view of Hamalainen as Claim 15 depends from allowable subject matter.

Applicant respectfully submits that Claim 15 includes all of the limitations of independent Claim 1 and further serves to narrow the scope of independent Claim 1.

In this regard, Applicant submits that the asserted combination of Houstis, Dunn and Hamalainen does not disclose or suggest an apparatus for providing educational materials, which has all of the recited features of independent Claim 1, and wherein said processing device processes a financial transaction involving said educational material, all of which features are specifically recited features of Claim 15.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of Claim 15. Applicant further respectfully submits that the present invention, as defined by Claim 15, is patentable over Houstis in view of Dunn and further in view of Hamalainen. In this regard, Applicant respectfully submits that the Examiner's rejection of Claim 15 is improper and should be reversed by the Board. Accordingly, Applicant respectfully requests that the Examiner's rejection of Claim 15 be reversed.

IX. CONCLUSION:

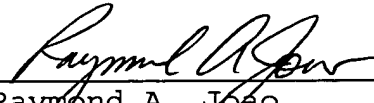
In view of the foregoing, Applicant respectfully submits that the Examiner's rejection of Claims 1, 2, 4-7, 9, 11-19, and 21-26, is improper and untenable.

Applicant respectfully submits that the present invention, as defined by Claims 1, 2, 4-7, 9, 11-19, and 21-26, is patentable over the prior art. Applicant further respectfully submits that the Examiner's rejection of claims 1, 2, 4-7, 9, 11-19, and 21-26 should be reversed by the Board.

Accordingly, the reversal of the Examiner's rejection of claims 1, 2, 4-7, 9, 11-19, and 21-26, and the allowance of Claims 1, 2, 4-7, 9, 11-19, and 21-26, is respectfully requested.

Appendix A, containing the Claims on Appeal, and
Appendix B, containing a Table of Authorities, are attached
hereto.

Respectfully Submitted,



Raymond A. Joao
Reg. No. 35,907

Encls.: - Check for \$155.00 for the required fee;
- Copy of REQUEST FOR A ONE-MONTH EXTENSION OF TIME
TO FILE AN APPEAL BRIEF, filed July 11, 2001;
- Copy of Petition For Extension Of Time Under
1.136(a), filed July 11, 2001;
- Copy of Check in the amount of \$55.00 for the
required fee under 37 CFR 1.17(a)(1), filed
July 11, 2001; and
- Copy of return receipt postcard evidencing receipt
of the above REQUEST FOR A ONE-MONTH EXTENSION OF
TIME TO FILE AN APPEAL BRIEF, Petition For
Extension Of Time Under 1.136(a) and Check in the
amount of \$55.00, by the U.S. Patent and Trademark
Office.

August 10, 2001

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APPENDIX A: CLAIMS ON APPEAL

1. An apparatus for providing educational materials, comprising:

a processing device for processing a request from an individual to receive educational material, wherein said educational material is at least one of video material, audio material, and video and audio material;

a memory device for storing said educational material;

a transmitter for transmitting said educational material to the individual in response to said request to receive said educational material, wherein said transmitter is controlled by said processing device; and

a receiver for receiving a transmission termination signal from the individual,

wherein said processing device terminates the

transmission of said educational material in response to the termination signal, and further wherein said processing device at least one of identifies, records, and stores, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated, and further wherein a subsequent transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material, and further wherein said subsequent transmission of said educational material includes a transmission of at least a portion of said educational material previously transmitted to the individual.

2. The apparatus of claim 1, wherein said education material is at least one of encoded, marked, digitally encoded, analog encoded, digitally marked, analog marked, time-marked, time-stamped, and frame numbered, and further wherein said processing device processes said first location in conjunction with an amount of educational material review to generate said second location.

4. The apparatus of claim 1, wherein said memory device is linked to one of a computer system, a database, a

data source, and an educational information source, located external from said apparatus.

5. The apparatus of claim 1, wherein said transmitter transmits one of an announcement, an update, and information, to the individual, wherein said one of an announcement, an update, and information, contains at least one of educational material, administrative material, testing material, registration material, scheduling material, course material, and program material.

6. The apparatus of claim 1, wherein said transmitter transmits educational material containing at least two of multimedia information, audio information, video information, graphical information, text information, and a live broadcast, simultaneously.

7. The apparatus of claim 1, wherein said processing device computes said second location one of during a current educational session and prior to a subsequent educational session.

9. The apparatus of claim 1, wherein said receiver receives a request from an individual to receive said educational material, and further wherein said processing device identifies said educational material requested.

11. The apparatus of claim 1, further comprising:

a remote user device for receiving said educational material at a location remote from said processing device.

12. The apparatus of claim 11, wherein at least one of said apparatus and said remote user device further comprise:

a video recording device for facilitating video conferencing between users of the apparatus.

13. The apparatus of claim 1, further comprising:

an input device for entering information concerning an update in the individual's one of status and progression related to said one of a course and a program of study,

wherein said processing device processes said information and stored said information in said memory device.

14. The apparatus of claim 1, wherein said processing device generates a notification signal containing information regarding at least one a course, a lecture, a program, and an information update regarding same, and further wherein said transmitter transmits said notification signal to one of the individual, a communication device associated with the individual, and a remote user device associated with the individual.

15. The apparatus of claim 1, wherein said processing device processes a financial transaction involving said educational material.

16. A method for providing educational materials in a network environment, comprising:

storing educational material;

processing a request from an individual to

receive said educational material, wherein said educational material is at least one of video material, audio material, and video and audio material;

transmitting said educational material to the individual in response to said request to receive said educational material;

receiving a transmission termination signal from the individual;

processing said transmission termination signal;

terminating the transmission of said educational material;

at least one of identifying, recording, and storing, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated,

wherein a subsequent transmission of said

educational material to the individual commences from a second location which is located before said first location in said educational material, and further wherein said subsequent transmission of said educational material includes a transmission of at least a portion of said educational material previously transmitted to the individual.

17. The method of claim 16, wherein said education material is at least one of encoded, marked, digitally encoded, analog encoded, digitally marked, analog marked, time-marked, time-stamped, and frame numbered, and further wherein said method further comprises:

processing said first location in conjunction with an amount of educational material review to generate said second location.

18. An apparatus for providing educational materials, comprising:

a memory device for storing educational material, wherein said educational material is at least one of video material, audio material, and video and audio material;

a receiver for receiving a request from an individual to receive said educational material;

a processing device for processing said request;
and

a transmitter for transmitting said educational material to the individual,

wherein said receiver receives a transmission termination signal from the individual, and wherein said processor processes said transmission termination signal and terminates the transmission of said educational material, and further wherein said processor at least one of identifies and stores a first location in said educational material where said transmission is terminated, wherein a subsequent transmission of said educational material commences from a second location, wherein said second location is a location in said educational material which is located before said first location and includes an amount of educational material review during said subsequent transmission.

19. The apparatus of claim 18, wherein said

processing device processes said first location in conjunction with an amount of educational material review to one of determine, compute, and generate said second location one of subsequent to the termination of a transmission of said educational material and prior to a subsequent transmission of said educational materials to the individual.

21. The apparatus of claim 1, further comprising:

a transmitter for transmitting information regarding at least one of said first location, an amount of educational material review, and said second location, to the individual.

22. The apparatus of claim 1, wherein said processing device at least one of determines whether an individual has progressed through at least one of said educational material, a segment of said educational material, and a portion of said educational material, determines whether the individual has submitted assignments related to said educational material, and determines whether the individual has taken a required examination.

23. The apparatus of claim 18, wherein said processor determines whether an individual has progressed through at least one of said educational material, a segment of said educational material, and portion of said educational material, and further wherein said processor determines whether the individual has at least one of submitted an assignment related to said educational material and has taken a required examination, and further wherein said processor generates a first signal indicative of at least one of the individual's successful completion of said educational material and the individual's failure to successfully complete said educational material, and further wherein said transmitter transmits said first signal to at least one of the individual, an administrator, an instructor, and a third party.

24. The apparatus of claim 1, wherein said receiver receives a request from the individual to at least one of re-view and replay at least one of said educational material, a segment of said educational material, and a portion of said educational material.

25. An apparatus for providing educational materials, comprising:

a processing device for processing a request from an individual to receive educational material, wherein said educational material is at least one of video material, audio material, and video and audio material;

a memory device for storing said educational material;

a transmitter for transmitting said educational material to the individual in response to said request to receive said educational material, wherein said transmitter is controlled by said processing device; and

a receiver for receiving a transmission termination signal from the individual,

wherein said processing device terminates the transmission of said educational material in response to the termination signal, and further wherein said processing device at least one of identifies, records, and stores, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated, and further wherein a

subsequent transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material, and further wherein said processing device stores information regarding at least one of said first location and said second location in an educational file corresponding to the individual, and further wherein said subsequent transmission of said educational material includes a transmission of an amount of educational material review.

26. The apparatus of claim 25, wherein said amount of educational material review is at least one of programmably selected and selected by at least one of an administrator, an educator, and the individual.

APPENDIX B: TABLE OF AUTHORITIES

In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998)

In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999)